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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 09/937,999   | 09/27/2001  | Horst Berneth        | MO-6633/LEA 33,661    | 8752             |
| 157  | 7590        | 03/04/2004           | EXAMINER              |                  |
| BAYER POLYMERS LLC<br>100 BAYER ROAD<br>PITTSBURGH, PA 15205 |             |                      | ANGEBRANNDT, MARTIN J |                  |
|  |             |                      | ART UNIT              | PAPER NUMBER     |
|  |             |                      | 1756                  |                  |
| DATE MAILED: 03/04/2004                                      |             |                      |                       |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |   |                                       |  |
|------------------------------|---|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/937,999    | <b>Applicant(s)</b><br>BERNETH ET AL. |  |
|                              | <b>Examiner</b><br>Martin J Angebranndt | <b>Art Unit</b><br>1756               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5,6,10,11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,10,11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The response by the applicant has been read and given careful consideration. Responses to the argument of the applicant are presented after the first rejection to which they are directed. Rejections of the previous office action not repeated below are withdrawn based upon the amendment of the claims, specifically the recitation of specific polymers and copolymers in independent claim 1.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3,5,6,10,11 and 13-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, p, x and y are undefined.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3,5,6,10,11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berneth et al. DE 19703132.

See copolymers on pages 10-15. These are evaluated on the basis of their absorption maxima when coated 0.9 microns thick on a glass substrate and written upon using an argon ion laser at a laser power of 250 mW (9/5-9). See dye monomer on 10/55 (similar to that at 12/10 of instant specification), dye monomer at 11/35 (similar to that at 12/15 of instant specification),

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dye monomer at 12/10 (similar to that at 11/8 of instant specification), dye monomer at 13/30 (similar to that at 12/20 of instant specification), dye monomer at 15/15 (similar to that at 13/7 of instant specification)

It would have been obvious to one skill in the art to modify the co-polymer of formula 8 by either adding the second monomer shown in formula 7 or replacing the second monomer of formula 8 with the second monomer shown in formula 7 with a reasonable expectation of forming a useful optical recording medium based upon equivalent function. This combination anticipates the co-polymer of formula XVIII shown in claim 1.

6. Claims 1-3,5,6,10,11 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berneth et al. DE 19703132, in view of Savant et al. '221.

Savant et al. '221 in example V describes the azo dyes bound to a polyethylene vinyl alcohol backbone and coated to a thickness of 10 microns. Examples XIII to XX describe thicknesses of 10 to 150 microns (0.1 to 0.15 mm) with dye loading concentrations of 10% as the best (23/53-55). The storage of multiple holograms in the same spot by controlling the angle between the incident (object) and reference beams is disclosed. (25/46-57 and 7/11-15). Suitable polymers are disclosed in columns 8-10. Useful azo dyes are disclosed in columns 9-17. The formation of thicknesses of 10-1000 microns by spin coating is disclosed. (18/51-66). The lowest layer in figure 3 is a reflective layer.

It would have been obvious to one skilled in the art to modify the examples of Berneth et al. DE 19703132 by adding a reflective film as taught by Savant et al. '221 to allow the reading of data by reflection as shown in figure 3.

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and

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useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claim 1-3,5,6,10,11 and 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 and 20-21 of copending Application No. 09/936122. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims seek coverage for the same media and specifically embrace the same monomeric azo materials through active recitation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The examiner has reviewed the most recent amendment to 09/936122 and notes that they seem to embrace the dye being bound to the polymer as well as being dispersed in the polymer. The 09/936114 has been abandoned. The applicant has withheld comment. The rejection over 09/936122 stands.

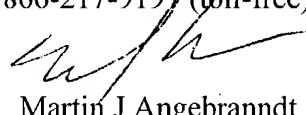
If there are other copending applications relevant to the prosecution of the instant application, the examiner would appreciate the applicant making these of record.

9 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebrannt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Martin J Angebranndt  
Primary Examiner  
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